Examiner's care in pointing out the objection is appreciated.

Claims 23-28 have been rejected as being obvious on the basis of Murata et al. '743, in view of Lowe et al '401, Best '073, Best '152 *and* Cookson et al '950., for reasons set forth in paragraph 2 of the Office Action. In paragraph 4 of the Office Action, the Examiner has remarked why the arguments filed by applicants with the last filed Amendment were not deemed persuasive. In doing so, the Examiner appears to have repeated the rejections, at least in part, but did not address the salient or critical distinction discussed in the last filed Office Action, starting at page 8. Murata was distinguished as not being spontaneous or creative. The difference is almost like comparing random and pre-selected, arbitrary and ordained, or arbitrary and predictable. Thus, as previously explained, one can almost predict what message(s) will get generated by Murata on the basis of the type of play involved. This is particularly true after a player has used the Murata device and has become familiar with the messages and knows what to expect. This type of predictability does nothing to enhance the interest and excitement of the game. On the other hand, with the present invention the message announced adjusts to the nature of the event. However, the messages are spontaneous and

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relevant and, yet, unpredictable. The present invention is, therefore, much more realistic and better simulates the nature of the announcements in an actual setting.

The Examiner has formulated the Final Rejection on the basis of obviousness when considering the primary Murata patent in view of or when combined with *four additional* references. However, the Examiner seems to confuse non-predictability resulting from switching an increased number of databases and the ability of the subject invention to automatically provide unpredictability by the inherent nature of the system. Being predictable because of a larger database does not result in unpredictability, as the Examiner suggests. Real unpredictability results from randomness, and not from an ordained selection from a larger pool. Therefore the Best patents add nothing to Murata. The same is true of Cookson, which by the Examiner's own statement may teach the manipulation of databases. For the aforementioned reasons, these references, separately or in combination, do not teach or suggest the present invention. No one reference, and no combination, suggests the randomly selection of one of a plurality of related, equally appropriate words or phrases. It is respectfully submitted that the secondary references add nothing to Murata, which the

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Examiner explicitly concedes needs more than its own teachings to render the present invention obvious.

Additionally, applicant respectfully disagrees that it would have been obvious to combine the teachings of Murata with the teachings of the *four* secondary references without the hindsight of the subject application and the teachings contained therein. First, the Examiner has not explained why it would be obvious to a person skilled in the art to combine the references as has been proposed by the Examiner. Second, for the reasons aforementioned, the combination, even if made, would not result in the invention as claimed. There would be no incentive for one skilled in the art to make the combination and, then, to make the additional modifications needed to arrive at the present invention. Nothing in the Examiner's rejection suggests how this could be otherwise. Applicant's traversal, then, is believed to be strongly confirmed by the fact that the references cited by the Examiner have been selected from several diverse classes and subclasses, many of which are directed to very different arts. One expert in *one* of these arts would not necessarily be expert in the *other* arts. Again, without a clear incentive to combine *five* references, it is almost necessary to conclude that

obviousness cannot exist and that any proposal to combine so many references could only be made through a "hindsight reconstruction" – something clearly forbidden by the Court of Appeals for the Federal Circuit and by the Patent Act.

Applicant also respectfully request that the finality of the Office Action be withdrawn. Under MPEP 706.07(b), it is clear that upon the re-filing of a CPA application, a Final Rejection as a first Office Action is only proper when the rejection would have been "properly" finally rejected on the grounds of the art of record. However, for the reasons discussed above, applicants believe that the five references relied upon by the Examiner are an improper combination and could not have been the basis for a rejection in the earlier application, even if drawn to the same invention. In this case, it is noted, applicant submitted a Preliminary Amendment to further define the invention. This Preliminary Amendment further removed the invention from the invention as claimed in the parent application.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the outstanding rejections in the parent application and withdraw the

same. It is believed that this continued prosecution application is in condition for

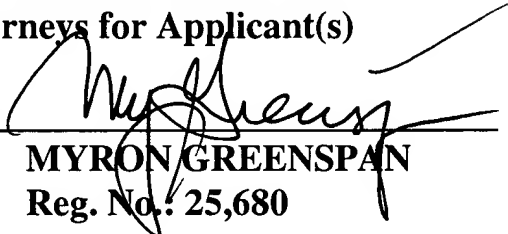allowance. Early allowance and issuance is, accordingly, respectfully solicited.

Dated: March 8, 2001   **Respectfully submitted,**

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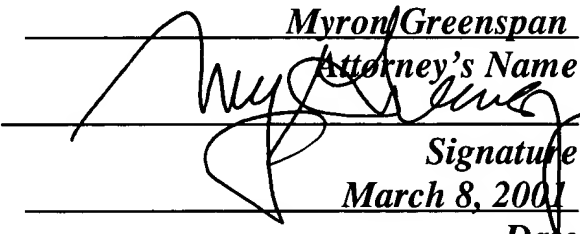(914) 723-4300   MYRON GREENSPAN
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MG/as

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Myron Greenspan
Attorney's Name

Signature
March 8, 2001
Date

Applicant hereby petitions that any and all extensions of time of the term
necessary to render this response timely be granted. Costs for such extension(s)
and/or any other fee due with this paper that are not fully covered by an
enclosed check may be charged to Deposit Account #10-0100.

ATTACHMENT: Amended claims 23 and 34-36, with editing marks.

23. (Twice Amended) A speech outputting game machine, comprising:

a plurality of phrase databases each corresponding to predetermined

condition and each storing a plurality of command data including at least one or

more commands representing a plurality of phrases some of which are related and

equally appropriate for a specified predetermined condition, at least a first

database having stored therein phrases in the voice of a first person and at least a

second database having stored therein phrases in the voice of a second person ;

switching means for switching from one of said first and second

databases to the other of said first and second databases;

processing means for selecting a phrase database corresponding

to a predetermined condition when said predetermined condition is

satisfied during the progress of the game, for selecting a specific

command data based on predetermined procedures among the

plurality of command data stored in the selected phrase database, and

for outputting one of a plurality of alternative related phrases based

on the command included in the selected specific command data; and

a speech output device for outputting a speech based on the phrase

output from said processing means, whereby different ones of said plurality of alternative related phrases may be generated [uon] upon the occurrence of the same condition during the progress of the game.

34. (Twice Amended) A recording medium storing a program for causing a game machine to realize predetermined functions, comprising:

means for storing a plurality of phrase databases each corresponding to a predetermined condition, wherein said phrase databases store a plurality of command data including at least one or more commands representing a plurality of phrases some of which are related and equally appropriate for a specified predetermined condition, respectively;

means for selecting a phrase database corresponding to said predetermined conditions when said predetermined conditions are satisfied during the progress of the game, selecting a specific command data based on predetermined procedures among the plurality of command data stored in the selected phrase database, and outputting one of a plurality of alternative related phrases based on the command included in the selected specific command data; and

means for outputting to a speech output device said output phrase

data, whereby different ones of said plurality of alternative related phrases may be generated [uon] upon the occurrence of the same condition during the progress of the game.

35. (Amended) A speech outputting method in a game machine, comprising the steps of:

storing a plurality of phrase databases each corresponding to a predetermined conditions, wherein said phrase databases store a plurality of command data including at least one or more commands representing a plurality of phrases some of which are related and equally appropriate for a specified predetermined condition[;] _,_ respectively;

selecting a phrase database corresponding to said predetermined conditions when said predetermined conditions are satisfied during the progress of the game, selecting a specific command data based on predetermined procedures among the plurality of command data stored in the selected phrase database, and outputting one of a plurality of alternative related phrases based on the command included in the selected specific command data; and

outputting to a speech output device said output phrase data.

36. (Twice Amended) A speech outputting method in a game machine

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according to claim 35, further comprising the step of replacing a first phrase

database with a second phrase database having different contents therefrom

according to predetermined replacement conditions, whereby different ones of said

plurality of alternative relative phrases may be generated [uon] upon the

occurrence of the same condition during the progress of the game.